

REMARKS

The claims remaining in the application are 20 through 23 and 27 through 35. Claims 31-35 are new. Claims 20-23 and 27-30 are rejected.

Rejection Under 35 U.S.C. §102(b) Over Balbach

The Examiner has rejected claims 20-23 and 27-30 under 35 U.S.C. §102(b) as allegedly being anticipated by the translation of DE 3724573 C1 (Balbach).

On page 2, line 6, the Examiner contends that the structure shows the invention of the claims. It shows the reaction product of toluene diisocyanate or diphenylmethane diisocyanate (MDI) with an ethoxylated alcohol at NCO/OH ratio of 1/1.

The Applicants would respectfully traverse.

A patent claim is anticipated, and therefore invalid, only when a single prior art reference discloses each and every limitation of the claim. *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 U.S.P.Q.2d 1565 (Fed. Cir.), cert. denied, 116 S.Ct. 516 (1995).

The Applicants respectfully note that Balbach concerns suspending agents for aqueous synthetic resins comprising diurethane derivatives and fatty alcohol oxyalkylates. These are suspending agents for the production of aqueous synthetic resin coating dispersions. It is respectfully noted that all of the claims herein recite a *polish (wax)* comprising an amount of a coupled alcohol ethoxylate *effective to improve adhesion* (emphasis added). It is thus respectfully submitted that Balbach does not disclose at least two components of every claim. Balbach does not disclose: (1) a polish or wax, and (2) a coupled alcohol ethoxylate in an *amount effective to improve adhesion*. Indeed, as far as can be determined, Balbach is completely silent about polishes or waxes, and is further silent with respect to any improvements in adhesion. The preamble of a claim is nevertheless part of the claim. In *Kropa v. Robie*, 187 F.2d 150, 152, 88 U.S.P.Q. 478, 481 (CCPA 1951), the preamble recited "An abrasive article", and was deemed by the Court of Customs and Patent Appeals as essential to point out the invention described by the

claims, therefore the preamble served to define the structure of the article produced. The same is true here where the preamble defines the composition as a polish (wax). Because the single prior art reference does *not* disclose each and every limitation of the claim, it is respectfully submitted that for these reasons alone the rejection should be withdrawn.

The Examiner's attention is respectfully directed to new claims 31-35 which recite a polish (wax) comprising an amount of a coupled alcohol ethoxylate effective to improve adhesion *where the coupled alcohol ethoxylate comprises a saturated hydrocarbon chain of 20 carbon atoms or more*, and where the coupled alcohol ethoxylate *has a decrease in hygroscopic nature and an increase in thermal properties as compared with non-coupled alcohol ethoxylate*. With respect to the recitation that the coupled alcohol ethoxylate comprises a saturated hydrocarbon chain of 20 carbon atoms or more, this language is supported in the specification as originally filed on page 5, lines 15-17, and thus does not constitute new matter. It is respectfully noted that Balbach only teach "branched or linear, saturated or unsaturated with a carbon number of 12-20". Thus, the carbon number range recited in claims 31-35 is above that taught by Balbach and is not anticipated thereby.

Further with respect to Balbach, the reference teaches the use of diurethanes as components of aqueous dispersions of synthetic resins in which the diurethanes, along with certain fatty alcohol alkoxylates, serve to stabilize such dispersions by acting as thickening agents. Based on the ethylene oxide content, the ethoxylated alcohols Balbach uses would have a HLB > 18 whereas all the alcohol ethoxylates encompassed by the claims herein, as amended, have a HLB < 18. It is respectfully submitted that this would certainly not lead one having ordinary skill in the art to believe that diurethanes based on lower HLB ethoxylated alcohols should provide improved adhesion of polishes to substrates, as claimed herein.

"The relevant portions of a reference include not only those teachings which would suggest particular aspects of an invention to one having ordinary skill in the art, but also those teachings which would lead such a person away from the claimed invention." *In re Mercier*, 185 U.S.P.Q. 774, 778 (C.C.P.A. 1975). In accord are *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.* 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986) and *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed.

Cir. 1986), *on rehearing*, 231 U.S.P.Q. 160 (Fed. Cir. 1986), the latter decision instructing further that the inventor achieving the claimed invention by doing what those in the art suggested should not be done is a fact strongly probative of nonobviousness. For these additional reasons, taken alone, the single prior art reference does not disclose each and every limitation of the new claims 31-35.

Additionally, claim 35 recites that the polish has increased softening temperature and increased glass transition temperature ( $T_g$ ), which is not disclosed by the single Balbach reference, as far as can be determined. Support for the recitation in claim 35 is found in the application as filed on page 5, lines 7-9 and thus does not constitute an improper insertion of new matter. Because the single Balbach reference does not teach or suggest these features, it is respectfully submitted that claim 35 is not anticipated by Balbach, or obvious therefrom, for that matter.

Reconsideration is respectfully requested, as is the withdrawal of the instant rejection.

Rejection Under 35 U.S.C. §102(e) Over Markusch, et al.

The Examiner has rejected claims 20-23 and 27-30 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Pat. No. 6,403,702 to Markusch, et al.

The Examiner alleges that Markusch, et al. shows in Example 1, the reaction product of MDI with an ethoxylated alcohol at a NCO/OH ratio of 1/1.

The Applicants again respectfully traverses.

Again, a patent claim is anticipated, and therefore invalid, only when a single prior art reference discloses each and every limitation of the claim. *Glaxo Inc. v. Novopharm Ltd.*, *id.*

Markusch teaches diurethanes as non-migrating plasticizers for inclusion in formulations for making polyurethane cast elastomers, and processes for their preparation (Abstract). Again, it is respectfully noted that all of the claims herein recite a *polish (wax)* comprising an amount of a coupled alcohol ethoxylate *effective to improve adhe-*

sion (emphasis added). It is further respectfully submitted that Markusch, et al. does not disclose at least two components of every claim. Markusch, et al. does not disclose: (1) a polish or wax, and (2) a coupled alcohol ethoxylate in an amount *effective to improve adhesion*. Indeed, Markusch, et al. is completely silent about polishes or waxes, and is further silent with respect to any improvements in adhesion. Because the single prior art reference does *not* disclose each and every limitation of the claim, it is respectfully submitted that for these reasons alone the rejection should be withdrawn.

The Examiner's attention is again respectfully directed to new claims 31-35 which recite a polish (wax) comprising an amount of a coupled alcohol ethoxylate effective to improve adhesion where the coupled alcohol ethoxylate has a decrease in hygroscopic nature and an increase in thermal properties as compared with non-coupled alcohol ethoxylate. Please also see original dependent claim 27. The Applicants respectfully submit that Markusch, et al. is silent on these recited features as well and does not disclose, teach or suggest them. That is, the single prior art Markusch, et al. reference does not disclose each and every limitation of the claims. For these reasons alone, the rejection should be withdrawn.

Additionally, claim 35 recites that the polish has increased softening temperature and increased glass transition temperature ( $T_g$ ), which is not disclosed by the single Markusch, et al. reference. These properties discovered by the inventors herein argue *against* the use of such materials as plasticizers, the use of Markusch, et al. The result is that one having ordinary skill in the art reading Markusch, et al. would not be led to consider that such diurethanes made from ethoxylated alcohols would result in products showing the increases in thermal properties as claimed herein. Again, this single prior art reference teaches away from the claimed invention. *In re Mercier, id.* Because the single Markusch, et al. does not teach or suggest these features, it is respectfully submitted that claim 35 is not anticipated by Balbach, or obvious therefrom, for that matter.

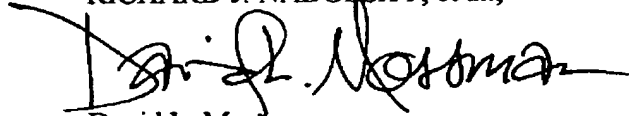
Reconsideration is respectfully requested, as is the withdrawal of the instant rejection.

It is respectfully submitted that the amendments presented above place the claims in condition for allowance. Reconsideration and allowance of the claims are respectfully

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requested. The Examiner is respectfully reminded of her duty to indicate allowable subject matter. The Examiner is invited to call the Applicant's attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,  
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